

Serial No. 09/556,875

REMARKS

This response is intended as a full and complete response to the non-final Office Action mailed December 17, 2004. In the Office Action, the Examiner notes that claims 1-37 are pending of which claims 21-37 are withdrawn from consideration and claims 1-20 are rejected. By this response, claims 1, 8, 11, 13 and 16 have been amended, claims 21-37 have been cancelled and claims 37-42 have been added. The amendments to claims 11 and 13 are to correct clerical errors in the originally filed claims. The amendments to the other claims and the newly added claims are fully supported by the Specification and Drawings. For example, the amendments to claims 1, 8 and 16 are supported at least by page 39, line 18, through page 44, line 19, and by Figure 11. The newly added claims are supported at least by the above-recited sections of the Specification and also by page 24, line 1, through page 25, line 13; page 23, lines 15-27; page 10, lines 13-20; and page 12, lines 15-19. Thus, no new matter has been added and the Examiner is respectfully requested to enter the amendments to the claims and the newly added claims.

In view of both the amendments presented above and the following discussion, the Applicants submit that none of the claims now pending in the application are indefinite or obvious under the respective provisions of 35 U.S.C. §112 and 103.

It is to be understood that the Applicants, by amending the claims, do not acquiesce to the Examiner's characterizations of the art of record or to the Applicants' subject matter recited in the pending claims. Further, the Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant response including amendments.

Amendments to the Specification

The Specification has been amended to clarify that the present application is, inter alia, a divisional of application serial number 09/191,520, which is a continuation-in-part of application Serial Number 08/711,742, which is now U.S. Patent No. 6,052,554. The Specification has also been amended to clarify that this application is also, inter alia, a continuation-in-part of application Serial Number 08/735,552, which is now U.S. Patent No. 6,160,989. The Specification has further been amended to clarify

339843-1

Serial No. 09/556,875

that this application is also, inter alia, a continuation-in-part of application Serial Number 08/352,205, which is now U.S. Patent No. 6,201,536.

Objections

Claim Objections

The Examiner has objected to claim 1 for lack of "antecedence for 'the authorization request.'" This limitation of Claim 1 has been amended to recite "a billing system that receives the authorization signal and generates a billing record" (emphasis added). Thus, the objected-to language has been removed and therefore the Examiner is respectfully requested to withdraw the objection.

Rejections

35 U.S.C. §112

The Examiner has rejected claim 13 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. In particular, the Examiner finds, regarding claim 13, line 1, that "the claim recites 'the time after start of the program,' however there is no antecedence for this limitation." Claim 13 has been amended to depend from claim 12, thus obviating this rejection, and therefore the Examiner is respectfully requested to withdraw the rejection.

35 U.S.C. §103

Claim 1

The Examiner has rejected claim 1 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,357,276 to Banker et al. (Banker '276). The Applicants respectfully traverse the rejection.

The Applicants' independent claim 1 recites (emphasis added below):

- "1. An apparatus that provides digital broadcast television programs to a subscriber, comprising;
 - a receiver module that receives program data and a local authorization code, wherein the authorization code allows the digital broadcast television programs to be decrypted for viewing;
 - a transmitter that sends a program selection to a scheduling web site, wherein the program selection is made from the program data;

Serial No. 09/556,875

the scheduling web site that receives the program selection and sends an authorization request to an order and authorization system;
 the order and authorization system that receives the authorization request, including the program selection, from the scheduling web site and generates an authorization signal, the authorization signal providing the local authorization code; and
 a billing system that receives the authorization signal and generates a billing record."

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 USPQ 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added). The Banker '276 reference fails to teach or suggest the Applicants' invention as a whole.

Specifically, the Banker '276 reference fails to teach at least the "a transmitter that sends a program selection to a scheduling web site, wherein the program selection is made from the program data; the scheduling web site that receives the program selection and sends an authorization request to an order and authorization system; the order and authorization system that receives the authorization request, including the program selection, from the scheduling web site and generates an authorization signal, the authorization signal providing the local authorization code;" as recited in the claim as amended.

Banker '276 discloses a subscription television system in which near video on demand (NVOD) events may be ordered by a subscriber. Information concerning available events is downloaded to the subscriber terminal from the headend in the form of event transactions (see column 9, lines 24-36). Banker '276 also discloses "[o]nce the subscriber has chosen the viewing mode that he wishes, the subscriber terminal 40 will determine whether the method of returning this information to the headend for billing and authorization is a RF or telephone return path." (column 10, line 66 – column 11, line 2) Banker further discloses "[i]f the subscriber terminal 40 has neither an RF or telephone return path, then another screen A36 must be entered from the screen A34 where the ANI number to order the event is displayed." (column 11, lines 15-19) The

339643-1

Serial No. 09/556,875

subscriber must then call this number to order the event. Thus, Banker '276 does not teach a scheduling web site that receives the program selection. Instead, the program selection is returned to the headend or a telephone operator. Furthermore, because Banker '276 does not teach or suggest a scheduling website, Banker '276 also does not teach that the scheduling web site sends an authorization request to an order and authorization system.

As such, the Applicants submit that independent claim 1 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Therefore, the Applicants respectfully request that the Examiner's rejection be withdrawn.

Claim 2-7

The Examiner has rejected claims 2-7 under 35 U.S.C. §103(a) as being unpatentable over Banker '276 in view of U.S. Patent 5,539,450 to Handelsman (hereinafter "Handelman"). The Applicants respectfully traverse the rejection.

The Banker '276 and Handelsman references fail to teach or suggest the Applicants' invention as a whole.

For at least the reasons discussed above, the Banker '276 reference fails to teach or suggest the Applicants' invention, as recited claim 1, as a whole.

Furthermore, the Handelsman reference fails to bridge the substantial gap between the Banker '276 reference and the Applicants' invention as recited in claim 1. Handelsman discloses a pay television gaming system. However, Handelsman also does not teach or suggest a scheduling web site that receives a program selection and sends an authorization request to an order and authorization system.

As such, the Applicants submit that independent claim 1 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Furthermore, claims 2-7 depend directly or indirectly from independent claim 1 and recite additional limitations thereof. As such and at least for the same reasons as discussed above, the Applicants submit that dependent claims 2-7 are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicants respectfully request that the Examiner's rejection be withdrawn.

339643-1

Serial No. 09/556,875

Claims 8 and 14

The Examiner has rejected claims 8 and 14 under 35 U.S.C. §103(a) as being unpatentable over Banker '276 in view of U.S. Patent 5,412,720 to Hoarty et al. ("Hoarty"). The Applicants respectfully traverse the rejection.

The Banker '276 and Hoarty references alone or in combination fail to teach the Applicants' invention as a whole.

For at least the reasons discussed above, the Banker '276 reference fails to teach or suggest the Applicants' invention, as recited in claim 1, as a whole. Moreover, independent claim 8 contains substantially similar relevant limitations as those discussed above in regards to claim 1. Therefore, the Banker '276 reference also fails to teach or suggest the Applicants' invention, as recited in claim 8, as a whole.

Furthermore, the Hoarty reference fails to bridge the substantial gap between the Banker '276 reference and the Applicants' invention as recited in claim 8. Hoarty discloses an interactive cable television system in which a subscriber can request a service by communicating over a backbone network to a server at a cable headend:

"FIG. 10 shows detail of the control channel routers 74 of FIG. 7. The control channel routers 74 of FIG. 7 cause to be performed authorization and billing service for subscribers seeking to view a movie or other information service provided to all nodes. In general in the case of interactive television, the node with which the subscriber is communicating makes data requests via the channel routers 74 to signal, over the backbone network 72 of FIG. 7, to the appropriate server. Each control channel router 74 of FIG. 7 may contain one or more pairs of cards diagrammed in FIG. 10. Each control channel router 74 handles two-way communication over a given trunk with the nodes downstream of the given trunk." (column 8, lines 1-14)

Thus, Hoarty also does not teach or suggest a scheduling web site that receives a program selection. Instead, a service is requested by communicating to a server at a cable headend. Furthermore, because Hoarty does not teach or suggest a scheduling website, Hoarty also does not teach that the scheduling web site sends and authorization request to an order and authorization system.

As such, the Applicants submit that independent claim 8 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder.

Furthermore, claim 14 depends directly from independent claim 8 and recites additional

339843-1

Serial No. 09/556,875

limitations thereof. As such and at least for the same reasons as discussed above, the Applicants submit that dependent claim 14 is also not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Therefore, the Applicants respectfully request that the Examiner's rejection be withdrawn.

Claims 9, 10 and 15

The Examiner has rejected claims 9, 10 and 15 under 35 U.S.C. §103(a) as being unpatentable over Banker '276 and Hoarty in view of Handelman. The Applicants respectfully traverse the rejection.

For at least the reasons discussed above, the Banker '276 and Hoarty references fail to teach or suggest the Applicants' invention as a whole, as recited in claim 8.

Furthermore, the Handelman reference fails to bridge the substantial gap between the Banker '276 and Hoarty references and the Applicants' invention as recited in claim 8. Handelman discloses a pay television gaming system. However, Handelman also does not teach or suggest a scheduling web site that receives a program selection and sends an authorization request to an order and authorization system.

As such, the Applicants submit that independent claim 8 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Furthermore, claims 9, 10 and 15 depend directly or indirectly from independent claim 8 and recite additional limitations thereof. As such and at least for the same reasons as discussed above, the Applicants submit that dependent claims 9, 10 and 15 are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and is patentable thereunder. Therefore, the Applicants respectfully request that the Examiner's rejection be withdrawn.

Claims 12 and 13

The Examiner has rejected claims 12 and 13 under 35 U.S.C. §103(a) as being unpatentable over Banker '276 and Hoarty in view of U.S. Patent 4,686,564 to Masuko et al. ("Masuko"). The Applicants respectfully traverse the rejection.

Serial No. 09/556,875

The Banker '276, Hoarty and Masuko references alone or in combination fail to teach or suggest the Applicants' invention as a whole.

For at least the reasons discussed above, the Banker '276 and Hoarty references fail to teach or suggest the Applicants' invention as a whole, as recited in claim 8.

Furthermore, the Masuko reference fails to bridge the substantial gap between the Banker '276 and Hoarty references and the Applicants' invention as recited in claim 8. Masuko discloses an external control unit for a CATV system. A subscriber may request the tuning of a TV channel for a pay program, and the request is transmitted to an external control unit (ECU):

"When a subscriber selects a channel, the subscriber operates a numeral key corresponding to a desired channel. A channel request signal is supplied from the corresponding SPU 13 to the ECU 12 and is decoded by the CPU 103. The CPU 103 reads out the tuning data corresponding to the channel request signal from the tuning data map 611 and supplies the readout data to the latch circuit 73." (column 16, lines 10-17)

Thus, Masuko also does not teach or suggest a scheduling web site that receives a program selection. Instead, Masuko discloses an external control unit which receives the channel request. Furthermore, because Masuko does not teach a scheduling web site, Masuko also does not teach or suggest a scheduling web site that sends an authorization request to an order and authorization system.

As such, the Applicants submit that independent claim 8 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Furthermore, claims 9, 12 and 13 depend directly or indirectly from independent claim 8 and recite additional limitations thereof. As such and at least for the same reasons as discussed above, the Applicants submit that dependent claims 12 and 13 are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicants respectfully request that the Examiner's rejection be withdrawn.

Claim 11

The Examiner has rejected claim 11 under 35 U.S.C. §103(a) as being unpatentable over Banker '276, Hoarty and Masuko in view of Handelman. The Applicants respectfully traverse the rejection.

339643-1

Serial No. 09/556,875

For at least the reasons discussed above, the Banker '276, Hoarty, and Masuko references fail to teach or suggest the Applicants' invention as a whole as recited in claim 8.

Furthermore, the Handelman reference fails to bridge the substantial gap between the Banker '276, Hoarty and Masuko references and the Applicants' invention as recited in claim 8. Handelman discloses a pay television gaming system. However, Handelman also does not teach or suggest a scheduling web site that receives a program selection and sends an authorization request to an order and authorization system.

As such, the Applicants submit that independent claim 8 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Furthermore, claim 11 depends indirectly from independent claim 8 and recites additional limitations thereof. As such and at least for the same reasons as discussed above, the Applicants submit that dependent claim 11 is also not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Therefore, the Applicants respectfully request that the Examiner's rejection be withdrawn.

Claim 16

The Examiner has rejected claim 16 under 35 U.S.C. §103(a) as being unpatentable over Banker '276 in view of U.S. Patent 5,317,391 to Banker et al. ("Banker '391"). The Applicants respectfully traverse the rejection.

For at least the reasons discussed above, the Banker '276 reference fails to teach or suggest the Applicants' invention, as recited in claim 1, as a whole. Moreover, independent claim 16 contains substantially similar relevant limitations as those discussed above in regards to claim 1. Therefore, the Banker '276 reference also fails to teach or suggest the Applicants' invention, as recited in claim 16, as a whole.

Furthermore, the Banker '391 reference fails to bridge the substantial gap between the Banker '276 reference and the Applicants' invention as recited in claim 16. Banker '391 discloses a subscriber terminal apparatus for a television in an in-band subscription television system. Banker '391 discloses that a user may buy a pay-per-view event by calling a system operator:

339643-1

Serial No. 09/556,875

"The PPV barker such as illustrated in FIG. 9H may be presented when a subscriber selects a channel showing a pay-per-view event and no preview time remains or has been provided. If the user calls and buys the event, the headend will authorize the subscriber terminal and the event may be viewed. This barker may also be presented when an IPPV channel is selected and an event is not purchasable, i.e., it is outside the purchase window. Thus, a subscriber is informed that a particular channel may not be viewed since it contains pay-per-view or impulse pay-per-view events. It is noted that this barker uses the channel identification information PPV1 which is described in greater detail in the above-referenced commonly assigned application." (column 12, lines 15-28)

Thus, Banker '391 also does not teach or suggest a scheduling web site that receives a program selection. Instead, Banker '391 discloses a system operator who receives the request by a telephone call. Furthermore, because Banker '391 does not teach a scheduling web site, Banker '391 also does not teach or suggest a scheduling web site that sends an authorization request to an order and authorization system.

As such, the Applicants submit that independent claim 16 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Therefore, the Applicants respectfully request that the Examiner's rejection be withdrawn.

Claim 17

The Examiner has rejected claim 17 under 35 U.S.C. §103(a) as being unpatentable over Banker '276 and Banker '391 in view of Masuko. The Applicants respectfully traverse the rejection.

For at least the reasons discussed above, the Banker '276 and Banker '391 references fail to teach or suggest the Applicants' invention as a whole as recited in claim 16.

Furthermore, the Masuko reference fails to bridge the substantial gap between the Banker '276 and Banker '391 references and the Applicants' invention as recited in claim 16. Masuko discloses an external control unit for a CATV system. A subscriber may request the tuning of a TV channel for a pay program, and the request is transmitted to an external control unit (ECU). Thus, Masuko also does not teach or suggest a scheduling web site that receives a program selection. Furthermore, because Masuko does not teach a scheduling web site, Masuko also does not teach or

Serial No. 09/556,875

suggest a scheduling web site that sends an authorization request to an order and authorization system.

As such, the Applicants submit that independent claim 16 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Furthermore, claim 17 depends directly from independent claim 16 and recites additional limitations thereof. As such and at least for the same reasons as discussed above, the Applicants submit that dependent claim 17 is also not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Therefore, the Applicants respectfully request that the Examiner's rejection be withdrawn.

Claims 18-20

The Examiner has rejected claims 18-20 under 35 U.S.C. §103(a) as being unpatentable over Banker '276 and Banker '391 in view of Handelman. The Applicants respectfully traverse the rejection.

For at least the reasons discussed above, the Banker '276 and Banker '391 references fail to teach or suggest the Applicants' invention as a whole as recited in claim 16.

Furthermore, the Handelman reference fails to bridge the substantial gap between the Banker '276 and Banker '391 references and the Applicants' invention as recited in claim 16. Handelman discloses a pay television gaming system. However, Handelman also does not teach or suggest a scheduling web site that receives a program selection and sends an authorization request to an order and authorization system.

As such, the Applicants submit that independent claim 16 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Furthermore, claims 18-20 depend directly or indirectly from independent claim 16 and recite additional limitations thereof. As such and at least for the same reasons as discussed above, the Applicants submit that dependent claims 18-20 are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicants respectfully request that the Examiner's rejection be withdrawn.

339643-1

Serial No. 09/556,875

Official Notices

The Office Action takes numerous Official Notices. Applicant hereby traverses each Official Notice. The Examiner alleges that apparatus and/or methods taught by certain limitations are well known in the art. However, the Applicant believes that these apparatus and/or methods rejected by the Examiner using Official Notice may not be well known within the art of the present invention as recited in the pending claims. For example, the allegedly well known limitations may not be well known to be used in combination with other limitations of the claims in which they are found or in claims form which they depend.

Serial No. 09/556,875

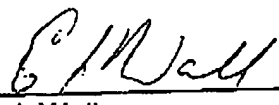
CONCLUSION

Thus, the Applicants submit that none of the claims presently in the application are indefinite or obvious under the respective provisions of 35 U.S.C. §112 and §103. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: 3/17/05


Eamon J. Wall
Registration No. 39,414
Attorney for Applicants

MOSER, PATTERSON & SHERIDAN, LLP
595 Shrewsbury Avenue, Suite 100
Shrewsbury, New Jersey 07702
Telephone: 732-530-9404
Facsimile: 732-530-9808